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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/653,425	05/24/1996	DAVID D. MURESAN		6148

7590 03/24/2003  
DAVID MURESAN  
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EXAMINER

LIANG, REGINA

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 03/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

**Application No.**

08/653,425

**Applicant(s)**

MURESAN ET AL.

**Examiner**

Regina Liang

**Art Unit**

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Solhjell (US. PAT. NO. 5,696,537).

Solhjell disclose a computer mouse having a magnetic core ball (64 in Fig. 11),

A third contact (the free rolling 18 as shown in Fig. 5) is replaced with a magnet (66 in Fig. 11), therefore, there is not third contact between the ball and another wheel as claimed.

### *Response to Arguments*

3. Applicant's arguments filed 1/31/03 have been fully considered but they are not persuasive.

Solhjell discloses a conventional computer mouse with a third contact (free rolling as shown in Fig. 5) have a drawback in that the force needed to move the ball is not optimized and can cause operator fatigue and decrease the operator's efficiency, for example see Solhjell col. 1 line 59 to col. 2 line 68. All of the embodiments as shown in Solhjell's Figs. 6-11 are directed to modifications to the free rolling contact of the computer mouse. Although the x and y rollers of the computer mouse are not shown in Figs. 6-11, however such is inherent in Figs.

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6-11 since Solhjell clearly teaches modifying the free roller of the conventional computer mouse as shown in Fig. 5. Furthermore, Solhjell on col. 3 lines 55-58 clearly stated "...in addition to those two which are used for x- and y-measurements", which clearly teaches that there are x and y rollers of the computer mouse but not shown to simplify the drawings. Fig. 11 is one embodiment showing a modification to the free roller using a magnetic pad instead of the conventional contact free roller to adjust the force applied to the ball.

Applicants' remarks in the paragraph bridging page 1 and page 2 are not persuasive. As clearly discussed above, Sohjell teaches modifying the free roller to adjust the force applied to the ball, thus by this modification Sohjell clearly teaches replacement or substitution of the third wheel which is the free roller with anyone of the embodiments shown in Figs. 6-11.

Applicants' reliance on the cited passage (col. 2 lines 19-38) is not persuasive since applicants have distorted the passage. In this passage Sohjell discloses conventional computer mice can have a total of three or four contact wheels, and as is well known in the art most computer mice use three wheels (such as shown in Fig. 5) for economic purposes. Therefore, applying Sohjell's teaching of modifying the free roller to provide means for adjusting the force applied to the ball, such as using the magnetic pad of Fig. 11, it will leave a mouse that normally has three wheels with only two wheels, namely the x- and y- contacts. The same analysis is also applicable in the case of a trackball. Hence, applicants' remarks are not persuasive.

Contrary to applicants' erroneous remarks as set forth in b, as clearly shown and disclosed by Sohjell, the free roller is modified to comprise a friction pad (Fig. 6), magnetic pad (Fig. 11), etc. all of which clearly show that the third wheel normally associated with a free roller is replaced! Sohjell also teaches that the ball is made of iron or similar magnetic sensitive

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material when a magnetic pad is used such that the ball is held by the x- and y- wheels (i.e. two wheels) and the use of magnetic force in a manner similar to applicants, hence if this is not possible in Sohjell than the same impossibility also applies to applicants' disclosure. Therefore, contrary to applicants' remarks, it is possible to use only two wheels and magnetic force to provide an operational mouse as taught by Sohjell.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (703) 305-4719. The examiner can normally be reached on Monday-Friday from 9AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

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**or faxed to:**

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

  
REGINA LIANG  
PRIMARY EXAMINER  
ART UNIT 2674

RL